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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,799	03/25/2004	Barry J. Lipsky	P68/500578.20072	6031

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REED SMITH, LLP
ATTN: PATENT RECORDS DEPARTMENT
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER

TRUONG, THANHNGA B

ART UNIT	PAPER NUMBER
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2135

MAIL DATE	DELIVERY MODE
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05/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/808,799	Applicant(s) LIPSKY ET AL.	
	Examiner Thanhnga B. Truong	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/24/08 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 24, 2008 has been entered. Claims 1-31 are pending. Claims 1-17 are cancelled by the applicant. At this time, claims 18-31 are rejected.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-20, 24-27, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff (US 2002/0116271 A1), and further in view of Cronic (US 7,032,240 B1)

a. *Referring to claims 18:*

i. Mankoff teaches in a system for coupling a hand held electronic reference product having an encrypted database file and a file system to a PC having a reader so that the PC can process the database file (see Figures 1-2 of Mankoff), the security validation subsystem comprising:

(1) a serial identification number for one of said hand held product and said file system (**paragraph [0032] of Mankoff**),

(2) a first voucher in said database file, said first voucher based on said serial identification number (**paragraph [0032] of Mankoff**), and

(3) a second voucher in said product at a location outside of said database file, said second voucher based on said serial identification number **(paragraph [0032] of Mankoff),**

(4) a comparator program within the PC reader to read and compare said first and second vouchers to provide a validation signal if said vouchers meet a predetermined correspondence comparison criterion **(paragraph [0032] Mankoff),**

(5) said validation signal permitting decryption (e.g., encryption scheme) by the PC of said database file **(paragraph [0032] of Mankoff).**

ii. Although Mankoff teaches the system for coupling a hand held electronic reference product having an encrypted database file and a file system to a PC having a reader so that the PC can process the database file (see Figures 1-2 of Mankoff), Mankoff is silent on the capability of showing the PDA or handheld device included a serial identification number (if indeed is not inherent). On the other hand, Cronce teaches this limitation in **column 11, lines 35-38 of Cronce.**

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Mankoff with the teaching of Cronce for authorizing the use of protected information and, in particular, to a portable authorization device (commonly known as a "dongle") for authorizing a host system to use protected information **(column 1, lines 15-19 of Cronce).**

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Mankoff with the teaching of Cronce to provide a portable authorization device that offers a high level of security to prevent unauthorized access to the authorization information when stored or being transmitted **(column 3, lines 37-40 of Cronce).**

b. Referring to claim 19:

i. Mankoff further teaches:

(1) said vouchers are based on a serial number in said file system **(paragraph [0032] of Mankoff).**

c. Referring to claim 20:

i. The combination of teaching between Mankoff and Cronce teaches the claimed subject matter. Mankoff and Cronce further teaches:

(1) said vouchers are based on a serial number of said hand held product **(paragraph [0032] of Mankoff and column 11, lines 35-38 of Cronce).**

d. Referring to claim 24:

i. Mankoff further teaches:

(1) said predetermined criterion is identity between said vouchers **(paragraph [0032] of Mankoff).**

e. Referring to claims 25-27 and 31:

i. These claims consist the security validation method of providing access by a PC to an encrypted database file stored in a hand held electronic reference product, said hand held electronic reference product having a file system to implement claims 18-20 and 24, thus they are rejected with the same rationale applied against claim 18-20 and 24 above.

4. Claims 21-23, 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff (US 2002/0116271 A1) as applied to claims 18 - 20 and 24 above, in view of Cronce (US 7,032,240 B1), and further in view of Kobayashi (US 6,708,182 B1).

a. Referring to claims 21-23, 28-30:

i. Although the combination of teaching between Mankoff and Cronce teaches the claimed subject matter, they are silent on the capability of including the voucher (e.g. message format) in the header field. On the other hand, Kobayashi teaches this limitation in **column 2, line 57 through column 3, line 14 of Kobayashi.**

ii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Mankoff with the teaching of Cronce for authorizing the use of protected information and, in particular, to

a portable authorization device (commonly known as a "dongle") for authorizing a host system to use protected information **(column 1, lines 15-19 of Cronic)**.

iii. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Mankoff with the teaching of Cronic to provide a portable authorization device that offers a high level of security to prevent unauthorized access to the authorization information when stored or being transmitted **(column 3, lines 37-40 of Cronic)**.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

/Thanhnga B. Truong/

Primary Examiner, Art Unit 2135

TBT

May 24, 2008

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